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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

LLP134WOUS

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]

on April 9, 2009

Signature /Christine Gillroy/

Typed or printed name Christine Gillroy

Application Number

10/502.037

Filed

July 20, 2004

First Named Inventor

Martin Bacher et al.

Art Unit

2611

Examiner

James M. Perez

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)

☒ attorney or agent of record.  
Registration number 36,981

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

/Thomas G. Eschweiler/

Signature

Thomas G. Eschweiler

Typed or printed name

(216) 502-0600

Telephone number

April 9, 2009

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Docket No. LLP134WOUS

10299US/LG/rs

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re **PATENT** application of:

Applicant: Martin Bacher et al.  
Serial No.: 10/502,037  
For: ELECTRONIC TRANSMITTER/ RECEIVER.  
Filing Date: July 20, 2004  
Examiner: James M. Perez  
Art Unit: 2611

**PRE-APPEAL BRIEF IN RESPONSE TO ADVISORY ACTION**  
**DATED MARCH 26, 2009**

Mail Stop Appeal Briefs - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Favorable reconsideration of the above-identified application is respectfully requested in view of the following remarks.

**REMARKS**

Claims 1 and 4-21 are pending in the application. Claims 31-40 were withdrawn from consideration. Reconsideration of the application is respectfully requested in view of the comments below.

**I. RESPONSE TO ADVISORY ACTION**

The Advisory Action of 3/26/09 rejects all applicant arguments in response to the Office Action of 1/09/09, stating that "one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of reference." (See, *In re Keller*, 642 F.2d 413 (CCPA 1981)). In *In re Keller*, the court set forth the

above holding to prevent overcoming an obvious type rejection by **a critical review of only a single reference** of a combination. However, that is not the case herein, since the O.A. of 1/9/09 specifically states that the AAPA does not teach the particular claim features at issue below, and instead relies upon Steudle to teach them. (See, p. 3, par. 3). Therefore, as set forth by the Office Action, the AAPA reference of the combination is already addressed in regard to the discussed features, and therefore the applicant's focus on the deficiencies of Steudle properly addresses the combination as a whole.

**II. REJECTION OF CLAIMS 1, 4-5, 14-16 AND 19-20 UNDER 35 U.S.C. §103(a)**

Claims 1, 4-5, 14-16 and 19-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of U.S. Pub. No. 2002/0006119 (Steudle). Withdrawal of the rejection is respectfully requested for at least the following reasons.

- i. The combination of AAPA and Steudle fails to disclose a puncturing device configured to output a data stream that indicates a position of empty locations in the output data stream, as recited in claim 1.***

Claim 1 is directed to an electronic transmitter device comprising a puncturing device that is configured to provide empty locations in the output data stream and **to output a signal that indicates a position of the empty locations in the output data stream**. The Office Action rejects the claim under 35 § U.S.C 103(a) stating that the claim is taught by a combination of AAPA and Steudle. The O.A. of 1/9/09 concedes that AAPA does not teach this feature (see, p. 3, par. 3), but states that based on the teaching of Steudle, one of ordinary skill in the art would be motivated to modify AAPA in accordance with the claimed invention. Therefore, the O.A. relies upon the teachings of Steudle to teach this feature within the combination, since the AAPA does not.

Specifically, in referencing the Steudle reference, the Office Action states:

Furthermore, Steudle teaches that **the puncturing device determines the location of the empty location (gaps)** and punctures said empty locations in to the output data stream,

***wherein the empty locations are not transmitted***

(abstract and paragraphs 7 and 8). One of ordinary skill in the art at the time of the invention would clearly recognize that it would be obvious for the puncturing device to provide a signal indicating the position of empty gaps in order to prevent the transmission of the empty location. (See O.A., 1/9/09, p.4, second full paragraph) (Emphasis added).

As will be separately set forth below, the above assertion is incorrect on two different, independent bases: (1) Steudle's puncturing device does not determine the position of the empty location in an output data stream, and (2) even if Steudle's puncturing device did determine empty locations, such teaching would not motivate one of ordinary skill in the art to output a signal that indicates the empty location positions as claimed.

***a. Steudle does not disclose a puncturing device that determines the position of empty locations in an output data stream.***

Steudle discloses a telecommunications system including a base station and at least one wireless terminal. As disclosed in paragraph [0011] of Steudle, measurement pattern parameters (that determine a manner of generating a measurement gap in a packet frame) are defined and transmitted to the wireless terminal ***via the base station***. As further discussed in paragraph [0012] ***the wireless terminal receives the measurement pattern parameters***, and then arranges (via a processor) gaps into a time-slot frame *via* a puncturing function. This functionality is again confirmed in paragraph [0013] of Steudle, wherein it unambiguously states that the measurement pattern parameters are defined operationally at the base station, and then transmitted to the wireless terminals. This functionality is still further confirmed in paragraph [0062] of Steudle, wherein the base station transmitter 400 transmits parameters to a wireless terminal receiver 420, which then uses a processor 430 to arrange the gaps into the time-slot frame according to the parameters. Clearly then, ***in Steudle the puncturing device resides in the wireless terminal, but such puncturing device does not determine the position of empty locations. Instead, such empty location***

***positions are dictated by the measurement pattern parameters that are defined at the base station*** and then transmitted to the wireless terminal that contains the puncturing device. Consequently, assertion (1) made in the Office Action that Steudle teaches a puncturing device that determines the position of empty locations is incorrect, and thus any resultant conclusion as to motivation of one of ordinary skill in the art to modify AAPA according to the claimed invention is incorrect. Accordingly, claim 1 is non-obvious over the cited art, and withdrawal of the rejection is respectfully requested.

- b. Even if Steudle did teach a puncturing device that determines the position of empty locations in an output data stream (which it does not), such teaching does not motivate one of ordinary skill in the art to provide a signal that indicates empty location positions, as recited in claim 1.***

To briefly recount assertion (2) made in the Office Action, it was contended that one of ordinary skill in the art at the time of the invention would clearly recognize that it would be obvious for the puncturing device to provide a signal indicating the position of empty gaps ***in order to prevent the transmission of the empty location***. As will be more fully appreciated below, the teaching of Steudle does not motivate one of skill in the art to provide a signal indicating the position of empty gaps because ***Steudle does not advocate preventing transmissions having empty locations***.

Steudle teaches in paragraph [0007] that parameter measurements are employed to interrupt a transmission by generating a gap in a data frame. Paragraph [0008] of Steudle further discusses various ways of inserting gaps into a data transmission in a compressed mode of operation. ***As clearly stated in Steudle, the insertion of such gaps is intentional, and is employed to force gaps in the data to be transmitted***. Therefore the rationale proffered in the Office Action that providing a signal to indicate empty location positions would be obvious to ***prevent transmission of the empty locations (gaps)*** makes no sense because Steudle discloses transmitting data having empty locations in the data frames. Clearly then, one of ordinary skill in the art would not be motivated to modify AAPA to include a signal that

indicates empty location positions based on the teaching of Steudle. Therefore the assertion (2) set forth in the Office Action is incorrect, and thus claim 1 is non-obvious over the cited prior art for at least this additional reason.

Claims 4-21 depend upon claim 1 and add further limitations thereto. Because, AAPA in view of Steudle in view of Schramm does not teach or suggest the invention of claim 1, withdrawal of the rejection of claims 4-21 is respectfully requested.

### **III. CONCLUSION**

For at least the above reasons, the claims currently under consideration are believed to be in condition for allowance.

Should the Examiner feel that a telephone interview would be helpful to facilitate favorable prosecution of the above-identified application, the Examiner is invited to contact the undersigned at the telephone number provided below.

Should any fees be due as a result of the filing of this response, the Commissioner is hereby authorized to charge the Deposit Account Number 50-1733, LLP134WOUS.

Respectfully submitted,  
ESCHWEILER & ASSOCIATES, LLC

By /Thomas G. Eschweiler/  
Thomas G. Eschweiler  
Reg. No. 36,981

National City Bank Building  
629 Euclid Avenue, Suite 1000  
Cleveland, Ohio 44114  
(216) 502-0600